



UNITED STATES PATENT AND TRADEMARK OFFICE

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COMMISSIONER FOR PATENTS  
UNITED STATES PATENT AND TRADEMARK OFFICE  
WASHINGTON, D.C. 20231  
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In re

:  
:  
: DECISION ON  
: PETITION FOR REGRADE  
: UNDER 37 CFR 10.7(c)  
:

**MEMORANDUM AND ORDER**

(petitioner) petitions for regrading his-her answers to questions 15, 28 and 44 of the morning section and questions 6, 11 and 46 of the afternoon section of the Registration Examination held on April 17, 2002. The petition is denied to the extent petitioner seeks a passing grade on the Registration Examination.

**BACKGROUND**

An applicant for registration to practice before the United States Patent and Trademark Office (USPTO) in patent cases must achieve a passing grade of 70 in both the morning and afternoon sections of the Registration Examination. Petitioner scored 65. On August 2, 2002, petitioner requested regrading, arguing that the model answers were incorrect.

As indicated in the instructions for requesting regrading of the Examination, in order to expedite a petitioner's appeal rights, a single final agency decision will be made regarding each request for regrade. The decision will be reviewable under 35 U.S.C. § 32. The Director of the USPTO, pursuant to 35 U.S.C. § 2(b)(2)(D) and 37 CFR 10.2 and 10.7, has delegated the authority to decide requests for regrade to the Director of Patent Legal Administration.

### **OPINION**

Under 37 CFR 10.7(c), petitioner must establish any errors that occurred in the grading of the Examination. The directions state: " No points will be awarded for incorrect answers or unanswered questions." The burden is on petitioners to show that their chosen answers are the most correct answers.

The directions to the morning and afternoon sections state in part:

Do not assume any additional facts not presented in the questions. When answering each question, unless otherwise stated, assume that you are a registered patent practitioner. The most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the USPTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a court decision, a notice in the Official Gazette, or a notice in the Federal Register. There is only one most correct answer for each question. Where choices (A) through (D) are correct and choice (E) is "All of the above," the last choice (E) will be the most correct answer and the only answer which will be accepted. Where two or more choices are correct, the most correct

answer is the answer that refers to each and every one of the correct choices. Where a question includes a statement with one or more blanks or ends with a colon, select the answer from the choices given to complete the statement which would make the statement true. Unless otherwise explicitly stated, all references to patents or applications are to be understood as being U.S. patents or regular (non-provisional) utility applications for utility inventions only, as opposed to plant or design applications for plant and design inventions. Where the terms “USPTO” or “Office” are used in this examination, they mean the United States Patent and Trademark Office.

Petitioner has presented various arguments attacking the validity of the model answers. All of petitioner's arguments have been fully considered. Each question in the Examination is worth one point.

No credit has been awarded for morning questions 15, 28 and 44, and afternoon questions 6, 11 and 46. Petitioner's arguments for these questions are addressed individually below.

Morning question 15 reads as follows:

15. Able is a registered solo practitioner. Ben asks Able to prepare and prosecute an application for a utility patent. As part of the application, Able prepares a declaration and power of attorney, which Ben reviews and signs. Able files the application, the declaration, and power of attorney with the USPTO. Able quickly recognizes that help is necessary and contacts another registered practitioner, Chris, who often assists Able in such instances. Able, with Ben's consent, sends a proper associate power of attorney to the Office for Ben's application and directs that correspondence be sent to Chris. The examiner in the application takes up the application in the regular course of examination and sends out a rejection in an Office action. Chris sends a copy of the action to Ben to obtain Ben's comments on a proposed response. Unfortunately, after the first Office action, Able becomes terminally ill and dies. Ben does not know what to do, so Ben calls the examiner at the number on the Office action and explains that A died and Ben is worried how to proceed. Which of the following statement(s) is/are true?

(A) Chris should inform Ben that the Office will not correspond with both the registered representative and the applicant and therefore, Ben should not have any further contact with the Office and let Chris send in a proper response.

(B) Ben should send in a new power of attorney for anyone Ben intends to represent him before the Office.

(C) Ben should execute and sent to the USPTO a new power of attorney for any registered patent practitioner that Ben intends to have represent him before the Office.

(D) (B) and (C).

(E) None of the above.

15. The model answer: (C). MPEP § 406. Answer (C) is a true statement because the Ben may appoint a registered practitioner to represent him. Answer (A) is incorrect because the power of a principal attorney will be revoked or terminated by his or her death. Such a revocation or termination of the power of the principal attorney will also terminate the power of those appointed by the principal attorney. Therefore, Chris's associate power of attorney is revoked and Chris cannot continue representing Ben without a new power of attorney from Ben. Furthermore, the Office will send correspondence to both Chris and Ben in the event of notification of Able's death. (B) is not the best answer because it suggests Ben may appoint a non-practitioner to prosecute the application and because it does not require the power of attorney to be executed (*cf.* answer (C)). (D) is not the best answer because it includes (B). (E) is false because (C) is true.

Petitioner argues that answer (D) is also correct. Petitioner's arguments have been fully considered but are not persuasive. Petitioner contends that answer (B) is equivalent to model answer (C) because the "anyone" of answer (C) cannot include anyone not qualified to practice before the Office. Petitioner is assuming, however, that Ben would

not intend anyone other than a registered practitioner to represent him. The fact pattern of this question might have warned petitioner not to make this assumption because the question includes the statement that, after Able's death, "Ben does not know what to do." Also, the directions for the examination state, "Do not assume any additional facts not presented in the questions". Further, the language "any registered patent practitioner" appearing in model answer (C) is not equivalent to the language "anyone" appearing in answer (B). Accordingly, model answer (C) is correct and petitioner's answer (D) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning questions 27 through 29 are based on the following factual background. Consider morning questions 27 through 29 independently of each other.

James Salt developed an environmentally friendly technique for controlling deer overpopulation. Briefly, Salt discovered a non- hormonal substance XYZ ("Antiagra") that efficiently suppresses sexual function in male deer with minimal side effects. Salt determined that the use of a non- hormonal substance eliminated adverse long-term health effects that may be experienced with hormonal substances. He then dissolved an effective amount of Antiagra in salt water, poured the resulting solution into a plurality of twenty-gallon tubs, and heated the tubs to evaporate the water. The resulting blocks of salt, throughout which Antiagra was evenly disbursed, were distributed in overpopulated areas during deer mating season to serve as salt licks. Stags that used the salt lick show no interest in mating, thereby lowering the pregnancy rate among does and helping to control the deer population. Salt has retained you to conduct a prior art search and, if appropriate, prepare and file a patent application. The only relevant prior art located during the prior art search is a patent to Deere that discloses a salt lick on which a hormonal substance is sprayed. A doe that uses the salt lick ingests the hormonal substance which, in turn, suppresses ovulation and thereby reduces the pregnancy rate. You prepare and file a patent application that provides a fully enabling disclosure and includes four claims sets. Claims 1-5 are directed specifically to the non-hormonal substance (Antiagra), claims 6-9 are directed to a salt lick laced with a non-hormonal substance that, when ingested by a male deer, suppresses sexual function in the male deer, claims 9-14 are directed to the method of forming the salt lick, and claims 14-20 are directed to a method for controlling deer population by distributing salt licks that are treated with an effective amount of XYZ to reduce pregnancy rates. You also properly establish small entity status on behalf of Salt at the time the application is filed.

Morning question 28 reads as follows:

28. Claim 6 of the application reads: "A composition for reducing the pregnancy rate among wild deer population, said composition comprising salt and a non-hormonal substance that, when ingested by a male deer, is operable to suppress sexual function in the male deer." Claim 7 reads: "The composition of claim 6, wherein said non-hormonal

substance is XYZ.” Claim 8 reads, “The composition of claim 6, wherein said composition is formed in a block and wherein said non-hormonal substance is interspersed substantially evenly throughout said block.” Each of these claims is fully supported by the specification. An Office action is mailed March 15, 2002. Claim 6 was rejected under 35 U.S.C. § 103 as being unpatentable over the Deere patent. Which of the following arguments, if presented in a timely reply to the March 15 Office action, is most likely to persuade the examiner to remove the § 103 rejection without presenting unpersuasive arguments?

(A) “The invention of claim 6 provides an advantageous feature in that the substance that helps reduce the pregnancy rate is interspersed throughout the salt lick. Thus, the present invention is effective to reduce the pregnancy rate in deer so long as any portion of the salt lick is available to deer. In contrast, the Deere patent utilizes a substance that is sprayed on the outer surface of the salt lick and, therefore, is effective only so long as the outer portion of the salt lick is available.”

(B) “The invention of claim 6 provides an advantageous feature in that the substance that helps reduce the pregnancy rate is interspersed throughout the salt lick. Thus, the present invention is effective to reduce the pregnancy rate in deer so long as any portion of the salt lick is available to deer. In contrast, the Deere patent utilizes a substance that is sprayed on the outer surface of the salt lick and, therefore, is effective only so long as the outer portion of the salt lick is available.”

(C) “In contrast to the present invention, the Deere patent calls for the use of a hormonal substance that suppresses ovulation in female deer. Deere neither discloses nor suggests the use of a non- hormonal substance that, when ingested by a male deer, is operable to suppress sexual function in the male deer, as set forth in claim 6.”

(D) “The present invention relates to a technique for reducing deer overpopulation by causing male deer to ingest a novel substance (XYZ) that is operable to suppress sexual function in the male deer. The Deere patent neither discloses nor suggests such a technique and, therefore, claim 6 is neither anticipated nor rendered obvious by the Deere patent.”

(E) “Applicant was aware of the Deere patent prior to filing of the present application, and the claims were carefully drafted to distinguish the present invention over the Deere patent. Accordingly, reconsideration and withdrawal of the § 103 rejection of claim 6 is respectfully requested.”

28. The model answer: The best answer is (C). Answers (A) and (B) are incorrect because they attempt to distinguish the claim on the basis of a feature that is not recited in claim 6, *i.e.*, the substance is interspersed throughout the salt lick. Cf. claim 8. Answer D similarly relies on a feature that is not set forth in claim 6, *i.e.*, presence of substance XYZ. With regard to Answer (E), a mere conclusory statement that the claim was

carefully drafted to distinguish over the prior art is unlikely to be persuasive without reference to distinguishing features set forth in the claim.

Petitioner argues that answer (D) is also correct. Petitioner's arguments have been fully considered but are not persuasive. Petitioner contends that "the word 'novel' is essentially the same as 'non-hormonal'...and because 'hormones' in this instance cannot be novel..." Aside from the fact that "novel" is not essentially the same word as "non-hormonal", the main portion of answer (D) that disqualifies it as a correct answer is the entire phrase reading "a novel substance (XYZ)", because substance XYZ is not recited in claim 6. A claim cannot be distinguished over the prior art based on subject matter that is disclosed, but not claimed. Accordingly, model answer (C) is correct and petitioner's answer (D) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 44 reads as follows:

44. An amendment filed in January 8, 2002, in an unassigned non-provisional application seeks to cancel claims so that fewer than all of the currently named inventors are the actual inventors of the invention being claimed. The amendment includes a request to delete the names of the persons who are not inventors. In accordance with proper USPTO rules and procedure, the request may be signed by which of the following?

(A) A registered practitioner not of record who acts in a representative capacity under 37 CFR 1.34(a).

(B) All of the applicants (37 CFR 1.41(b)) for patent.

(C) A registered practitioner of record appointed pursuant to 37 CFR 1.34(b).

(D) (B) and (C).

(E) (A), (B), and (C).

44. The model answer: (E) is the correct answer. 37 C.F.R. § 1.48(b) (effective November 7, 2000); "Changes To Implement the Patent Business Goals; Final Rule," 65 FR 54604, 54619 (September 8, 2000). As stated in 65 FR at 54619, middle column, "Sections 1.48(b) and (d) are revised to indicate that a request to correct the inventorship thereunder must be signed by a party as set forth in § 1.33(b)..." (A), (B), and (C) are provided for in 37 C.F.R. § 1.33(b). Thus (E), the most inclusive answer, is correct.

Petitioner argues that answer (B) is also correct. Petitioner's arguments have been fully considered but are not persuasive. Petitioner asserts that "the question allows the possibility that the inventors are operating without a registered practitioner" and therefore

answers (A) and (C), which are incorporated by model answer (E), are actually insufficient answers. The paragraph above explains why answers (A)-(C) are equally correct. Further, contrary to petitioners assertion, answers (A) and (C) do not provide for the possibility that “the inventors are operating without a registered practitioner.” Note, for instance, that appointment under 37 CFR 1.34(b) can only be done by a “principal registered attorney.” Accordingly, model answer (E) is correct and petitioner’s answer (B) is incorrect.

No error in grading has been shown. Petitioner’s request for credit on this question is denied.

Afternoon question 6 reads as follows:

6. Patent practitioner files a patent application on behalf of inventors X, Y and Z. The patent application includes ten claims. X, Y and Z are joint inventors of the subject matter of claims 1-5. X and Y are joint inventor of the subject matter of claims 6-8. Y invented the subject matter of claim 9. Z is the inventor of the subject matter of claim 10. A patent examiner properly rejects independent claim 10 under 35 U.S.C. § 102(a) as anticipated by reference A, which is not a patent. In an attempt to overcome this rejection, a declaration that clearly antedates reference A is filed under 37 CFR 1.131. The declaration is signed by inventor Z, but not by X and Y. The declaration is:

(A) improper because all named inventors of an application must sign a declaration filed under 37 CFR 1.131.

(B) improper because the patent practitioner did not sign the declaration.

(C) proper if it shows that inventor Z is the sole inventor of the subject matter of claim 10.

(D) proper because 37 CFR 1.131 has no requirement on who must sign the declaration.

(E) proper because 37 CFR 1.131 only requires that the declaration be signed by an inventor named in the application.

6. The model answer: (C) is the most correct answer. MPEP § 715.04 pages 700-207 and 208 (8th ed.), under the heading “WHO MAY MAKE AFFIDAVIT OR DECLARATION” states “[t]he following parties may make an affidavit or declaration under 37 C.F.R. [§] 1.131: ... (B) An affidavit or declaration by less than all named inventors of an application is accepted where it is shown that less than all named inventors of an application invented the subject matter of the claim or claims under rejection. For example, one of two joint inventors is accepted where it is shown that one of the joint inventors is the sole inventor of the claim or claims under rejection.” In addition, 37 C.F.R. § 1.131(a) states “... the inventor of the subject matter of the rejected claim ... or the party qualified under §§ 1.42, 1.43, or 1.47, may submit an appropriate



oath or declaration....” Accordingly, answer (A) is incorrect because a declaration with less than all named inventors is acceptable when it is shown that less than all named inventors of an application invented the subject matter of the claim under rejection. Answer (B) is incorrect because the declaration was properly signed. Answer (D) is incorrect because 37 C.F.R. § 1.131(a) expressly provides for who must sign the declaration. Answer (E) is incorrect because it is the inventor of the subject matter of the claim under rejection who must sign the declaration, not any inventor named on the application.

Petitioner argues that answer (A) is also correct. Petitioner’s arguments have been fully considered but are not persuasive. Petitioner contends that “A is correct *if* inventor Z is NOT shown to be ‘the sole inventor of the subject matter of claim 10.’” Answer (A) states that the very reason the declaration is improper is “because all named inventors of an application must sign a declaration filed under 37 CFR 1.131.” As there is no brightline rule that all joint inventors must sign a 37 CFR 1.131 declaration, answer (A) is incorrect. Accordingly, model answer (C) is correct and petitioner’s answer (A) is incorrect.

No error in grading has been shown. Petitioner’s request for credit on this question is denied.

Afternoon question 11 reads as follows:

11. While vacationing in Mexico on April 14, 2001, Henrietta invented a camera that operated at high temperature and is waterproof. She carefully documented her invention and filed a provisional application in the USPTO on April 30, 2001. She conducted tests in which the camera withstood temperatures of up to 350 degrees Fahrenheit. However, when the camera was placed in the water leaks were discovered rendering the camera inoperable. On April 12, 2002, Henrietta conceived of means that she rightfully believed will fix the leakage issue. Henrietta came to you and asked whether she can file another application. Henrietta desires to obtain the broadest patent protection available to her. Which of the following is the best manner in accordance with proper USPTO practice and procedure for obtaining the patent covering both aspects of her invention?

(A) She can file a nonprovisional application on April 30, 2002 claiming benefit of the filing date of the provisional application, disclosing the means for fixing the leak and presenting a claim covering a camera that operates at high temperatures and a claim covering a camera that is waterproof, or presenting a claim covering a camera that both operates at high temperatures and is waterproof.

(B) Henrietta cannot rightfully claim a camera that is waterproof in a nonprovisional application filed on April 30, 2002, since she tested the camera and the camera developed leaks.

(C) Henrietta can file another provisional application on April 30, 2002 and obtain benefit of the filing of the provisional application filed on April 30, 2001.

(D) Henrietta may establish a date of April 14, 2001 for a reduction to practice of her invention for claims directed to the waterproofing feature.

(E) Henrietta should file a nonprovisional application on April 30, 2002 having claims directed only to a camera that withstands high temperatures since the camera that she tested developed leaks.

11. The model answer: (A). As to (B) and (E), an actual reduction to practice is not a necessary requirement for filing an application so long as the specification enables one of ordinary skill in the art to make and use the invention. However, (D) is incorrect, as a reduction to practice may not be established since the camera leaked. As to (C), a second provisional is not entitled to the benefit of the filing date of the first provisional application. 35 U.S.C. § 111(b)(7).

Petitioner argues that model answer (A) is incorrect. Petitioner's arguments have been fully considered but are not persuasive. Petitioner contends that "[N]ew material (aside from claims) cannot be added to a non-provisional application claiming provisional priority." Petitioner's contention is false. There is no requirement that the subject matter of a nonprovisional application be limited to the subject matter of any provisional application to which priority is claimed. Of course, the benefit of 35 U.S.C. 119(e) priority only applies to subject matter in the nonprovisional application for which adequate support (per 35 U.S.C. 112, 1<sup>st</sup> paragraph) exists in the provisional application to which priority is claimed. Accordingly, model answer (A) is correct and petitioner's answer (B) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 46 reads as follows:

46. Which of the following is/are information which the USPTO may require an attorney of record in a reissue application to submit in a reply to a first Office action dated April 12, 2001?

(A) Information used in invention process: A copy of any non-patent literature, published application, or patent (U.S. or foreign) that was used in the invention process, such as by designing around or providing a solution to accomplish an invention result.

(B) The publication date of an undated document mentioned by applicant which may qualify as printed publication prior art.

(C) Comments on a new decision by the Federal Circuit that appears on point in the examination of the application.

(D) (A), (B), and (C).

(E) None of the above.

46. The model answer: (D) is the correct answer. 37 C.F.R. § 1.105(a) (effective November 7, 2000); “Changes To Implement the Patent Business Goals; Final Rule,” 65 FR 54604, 54634 (September 8, 2000). (A) is specifically stated as an example in 37 C.F.R. § 1.105(a)(1)(v). (B) and (C) are given as examples in 65 FR at 54634, left column, where the Office may require the submission of information. (E) is incorrect because (D) is correct.

Petitioner argues that answer (B) is correct, but model answer (D) is incorrect because it incorporates answers (A) and (C), which petitioner argues are incorrect. Petitioner’s arguments have been fully considered but are not persuasive. Contrary to petitioner’s statement that the USPTO cannot require the information identified by answers (A) and (C), the information identified by answer (A) is specifically stated as an example in 37 C.F.R. § 1.105(a)(1)(v) of information that may be required by the Office. Further, the information identified by answer (C) is given as an example in 65 FR at 54634, left column, of information that may be required by the Office. Accordingly, model answer (D) is correct and petitioner’s answer (B) is incorrect.

No error in grading has been shown. Petitioner’s request for credit on this question is denied.

**ORDER**

For the reasons given above, no point has been added to petitioner's score on the Examination. Therefore, petitioner's score is 65. This score is insufficient to pass the Examination.

Upon consideration of the request for regrade to the Director of the USPTO, it is ORDERED that the request for a passing grade on the Examination is denied.

This is a final agency action.

A handwritten signature in black ink, appearing to read 'Robert J. Spar', is positioned above a horizontal line.

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Robert J. Spar  
Director, Office of Patent Legal Administration  
Office of the Deputy Commissioner  
for Patent Examination Policy